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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,706	11/05/2003	Linda Van Patten Benhase	TUC920030059US1	7080
46263	7590	05/05/2006	EXAMINER	
SCULLY, SCOTT, MURPHY, & PRESSER 400 GARDEN CITY PL GARDEN CITY, NY 11530			CHEN, TE Y	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/701,706

Applicant(s)

BENHASE ET AL.

Examiner

Susan Y. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/05/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-19 are pending for examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-19, are rejected under 35 U.S.C. 101 because the claimed invention directs to non-statutory subject matter.

In the present case, the preamble of each independent claims (i.e., claims: 1, 8, 14) recite "paring objects for the purpose of copying data", however, the body of these claims does not include any functional steps of "paring objects" and "copying data", such that it can be referred back to the purpose as recited in the preamble.

Furthermore, the dependent claims (i.e., claims: 2-7, 9-13 and 15-19) also fail to resolve the defects of the independent claims respectively, therefore, the instant set of claims do not produce a concrete, useful and tangible result, it merely directs to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1, 8 and 14, applicant recites "pairing objects for the purpose of copying data", but the examiner does not see how and when "paring objects" and "copying data" was executed such that the action of "selecting such pairs..." will be fulfilled and the "implementing checks and alert messages..." are necessitated or associated respectively.

As to claims 2-7, 9-13 and 15-10, these claims have the same defects as their respective base claims, hence are rejected for the same reason.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-9, 11-15 and 17-19, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Publication No. 2004/0123,180 issued to Soejima et al. (hereinafter referred as Soejima).

Claim 1:

Soejima discloses method for pairing objects for the purpose of copying data [e.g., P2, Sections: 0034 – P. 3, 0040], comprising the steps:

selecting such pairs in a single view including graphical depictions of representations of storage resources [e.g., P. 10, Sections: 0147-0150, Fig. 22 & P. 16, Sections: 0227-0242, Fig(s). 25-28 and associated texts]; and

implementing checks and alert messages regarding such pairings based on predefined rules [e.g., Fig(s). 19, 22 & 28 and associated texts, specifically sections: P. 10, Sections: 0149-0150 & P. 11, Sections: 0169- 0170].

Claim 2:

Except the limitations recited in claim 1, Soejima further discloses graphical depictions are side-by-side depictions in the single view of a logical configuration of the storage resources [e.g., Fig. 25 and associated texts].

Claim 4:

Except the limitations recited in claim 1, Soejima discloses that the storage resources include a source subsystem having a multitude of source storage volumes, and a target subsystem having a multitude of target storage volumes; and each of the pairs consists of one of the source storage volumes and one of the target storage volumes [e.g., Soejima: the units: 28050, 28100, Fig. 28].

Claim 5:

Except the limitations recited in claim 4, Soejima discloses that the selecting step includes the steps of: selecting a number of source storage volumes; and selecting a number of target storage volumes; and wherein one of the checks ensures that the number of selected source storage volumes is equal to the number of selected target storage volumes [e.g., Soejima: P. 2, Sections: 0034-0039 & Fig. 5] .

Claim 6:

Except the limitations recited in claim 5, Soejima discloses the following:

the step of selecting a number of source storage volumes includes the step of identifying a set of source storage volumes [e.g., Soejima: unit 19050, Fig. 19];

the step of selecting a number of target storage volumes includes the step of identifying a set of target storage volumes [e.g., Soejima: unit 19060, Fig. 19]; and

the implementing step includes the step of, if the number of source storage volumes in the set thereof is not equal to the number of target storage devices in the set

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thereof, then displaying a message for indicating that the sets have unequal numbers of storage devices [e.g., Soejima: units: 19070-19160, Fig. 19].

Claim 7:

Except the limitations recited in claim 1, Soejima discloses the implementing step includes the step of also implementing error handling based on the predefined rules [e.g., Soejima: P. 11, Section: 0169-0170].

Claim 8:

This claim recites similar subject matters as claim 1 in form of system means, hence, is rejected along for the same reason.

Claim 9:

This claim recites similar subject matters as claim 2 in form of system means, hence, is rejected along for the same reason.

Claim 11:

This claim recites similar subject matters as claim 4 in form of system means, hence, is rejected along for the same reason.

Claim 12:

This claim recites similar subject matters as claim 5 in form of system means, hence, is rejected along for the same reason.

Claim 13:

This claim recites similar subject matters as claim 6 in form of system means, hence, is rejected along for the same reason.

Claim 14:

This claim recites similar subject matters as claim 1 in form of computer readable program storage medium, hence, is rejected along for the same reason.

Claim 15:

This claim recites similar subject matters as claim 2 in form of computer readable program storage medium, hence, is rejected along for the same reason.

Claim 17:

This claim recites similar subject matters as claim 4 in form of computer readable program storage medium, hence, is rejected along for the same reason.

Claim 18:

This claim recites similar subject matters as claim 5 in form of computer readable program storage medium, hence, is rejected along for the same reason.

Claim 19:

This claim recites similar subject matters as claim 6 in form of computer readable program storage medium, hence, is rejected along for the same reason.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 10 and 16, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2004/0123,180 issued to Soejima et al. (hereinafter referred

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as Soejima) in view of U.S. Patent No. 5,065,347 issued to Pajak et al. (hereinafter referred as Pajak).

Claim 3:

Except the limitations recited in claim 2, Soejima did not specifically disclose that graphical depictions are hierarchical trees.

However, Pajak disclose that graphical depictions are hierarchical trees [e.g., Abstract, col. 2, lines 63 – col. 3, lines 33].

Soejima and Pajak are both in the same field of endeavor to facilitate the data copying processing via geographical depictions, thus, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the well-known technique as taught by Pajak into Soejima's invention, because by doing so, as indicated by Pajak, the combined invention would be upgraded to provide working hierarchical tools to create, modify and access information for document creation and publications as well as support for structured analysis and design methods in a visually pleasing and easily accessible manner [e.g., Pajak: col. 2, lines 41-60].

Claim 10:

This claim recites similar subject matters as claim 3 in form of system means, hence, is rejected along for the same reason.

Claim 16:

This claim recites similar subject matters as claim 3 in form of computer readable program storage medium, hence, is rejected along for the same reason.

Conclusion

To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- 1) Kapitanski et al. (U.S. Patent No. 6,912,539) which discloses a system having method and means for verifying converted database commands.
- 2) Bharat (U.S. Patent No. 6,577,735) which discloses a system and method for backing-up data stored on a portable audio player.
- 3) Beach et al. (U.S. Patent No. 5,953,017) which discloses a compressed object display for organizing objects in a tree structure.

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2161

April 28, 2006

Susan Chen